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In re Application of	:	
Theodorus Joseph Aquarius et al	:	DECISION ON SECOND
Application No.: 10/031,111	:	
PCT No.: PCT/NL01/00351	:	
Int. Filing Date: 08 May 2001	:	RENEWED PETITION
Priority Date: 08 May 2000	:	
Attorney's Docket No.: A-71266/ESW	:	
For: DEVICE FOR MANUFACTURING...	:	UNDER 37 CFR 1.47(b)
AND TUBULAR FOIL	:	

This decision is in response to applicant's "SECOND RENEWED PETITION UNDER 37 CFR 1.47(b)" submitted on 03 March 2004.

BACKGROUND

In a decision from this Office on 27 October 2003, the petition filed on 25 August 2003 was dismissed. The decision stated that items (2), and (5) under 37 CFR 1.47(b) had not been met.

On 03 March 2004, applicants submitted this second renewed petition accompanied with the current petition, inter alia, a second supplemental statement of Mr. Wright, a declaration from Arthur Graham, and the employment contract between Flo-Pak BV and Straver.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Applicant has satisfied item (2) but has still not satisfied item (5) thus not completing the requirements under 37 CFR 1.47(b).

Regarding requirement (2) under 37 CFR 1.47(b), the averments of Messrs. Wright and Graham are sufficient to support a finding that the nonsigning inventors refused to sign the declaration as well as the assignment since a complete set of application papers were presented to their counsel at Vriesendorp and Mr. Wright, as requested in the previous decision, has provided a copy of the declaration sent to them and showing that it executes the PCT in the United States.

Regarding requirement (5) under 37 CFR 1.47(b), applicant has stated that Free-Flow Packaging has a proprietary interest based on one of the non-signing inventors, Mr. Straver's employment agreement with Free-Flow. Although applicant has submitted proof of Mr. Straver's employment agreement, the agreement does not establish that Flo-Pak BV has a proprietary interest in the invention with respect to Mr. Straver's participation because section 11 of the agreement states that "[a]ll such inventions, discoveries or designs shall be transferred to the Company upon written request of the employer." Applicant has not provided this written request to show that there has been a transfer.

In addition, applicant has not provided the employment contract between Mr. Aquarius and Flo-Pak BV that would demonstrate that Mr. Aquarius would assign his contribution of the invention to Flo-Pak BV. Moreover, it is unclear the relationship among Aquarius, Case and Free-Flow with respect to Free-Flow's proprietary interest derived from Aquarius' contribution. Consequently, it is unclear if Mr. Aquarius has assigned his part of the invention to Flo-Pak BV.

Accordingly, Flo-Pak BV has not yet shown that it has a proprietary interest to prosecute the above invention because applicant has not been able to establish this interest either through Mr. Straver or Mr. Aquarius. Applicant only needs to establish a proprietary interest from either Mr. Straver or Mr. Aquarius to prosecute the application. MPEP 409.03(f) outlines the requirement by 37 CFR 1.47(b) applicant to show a proper proprietary interest to prosecute an application. This section of the MPEP has been provided below:

409.03(f) Proof of Proprietary Interest:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that

- (A) the invention has been assigned to the applicant, or
- (B) the inventor has agreed in writing to assign the invention to the applicant, or
- (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

If the application has been assigned, a copy of the assignment (in the English language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324). An assignment of an application and any "reissue, division, or continuation of said application" does not itself establish an assignment of a continuation-in-part application. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956). An assignment to a 37 CFR 1.47(b) applicant for the sole purpose of obtaining a filing date for a 37 CFR 1.47(b) application is not considered an assignment within the meaning of 35 U.S.C. 118 and 37 CFR 1.47(b).

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an

agreement to assign is dependent on certain specified conditions being met, it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by a statement of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.

A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

Accordingly, it is not appropriate to accord the national stage application status under 37 CFR 1.47(b) at this time.

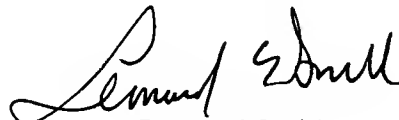
CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Third Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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